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OFFICE OF PETITIONS

MARIA A. TREVISAN
WOLF, GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210

In re Application :
Arthur M. Krieg et al. :
Application No. 10/613,524 : DECISION ON APPLICATION
Filed: July 3, 2003 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. :
C1037.70042US00

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705 filed April 27, 2009. Applicant requests that the determination of patent term adjustment be corrected from 752 days to 1254 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment

and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **GRANTED**.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is six hundred seventy eight (**678**) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On January 27, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 752 days. The instant application for patent term adjustment was timely filed¹ on or before payment of the issue fee.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 941 days for Office delay.

Applicants argue that following the submission of the RCE on October 30, 2008, Applicant filed a series of Information Disclosure Statements on December 10, 2008, December 22, 2008 and on January 12, 2009, resulting in delays of 41 days (period from 10/31/2008 to 12/10/2008), 53 days (period from 10/31/2008 to 12/22/2008), and 74 days (period from 10/31/2008 to 01/12/2009) for applicant delay. See 37 CFR § 1.704(c)(8).

¹ PALM records indicate that the issue fee was paid on April 27, 2009.

Applicant's argument is persuasive. A period of reduction should be entered for the Information Disclosure Statements (IDS) filed December 10, 2008, December 22, 2008 and January 12, 2009. The period of reduction pursuant to 37 CFR 1.704(c)(8) for filing the IDSs without a 1.704(d) statement after the request for continued examination is 74 days, counting the number of days in the period beginning on the day after the initial reply (the RCE) was filed, October 31, 2008 and ending on the date of filing of the last supplemental paper, the IDS filed January 12, 2009. Accordingly, a period of reduction of 74 days is being entered.

It is noted that under the circumstances entry of a period of reduction for the filing of the interview summary filed January 20, 2009 is not warranted.

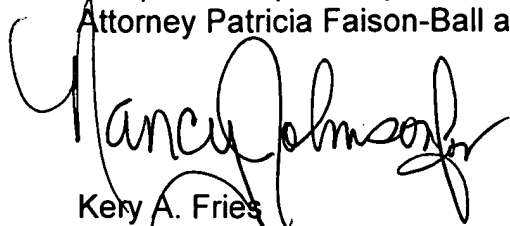
In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is six hundred seventy-eight (678) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Examination Policy

Enclosure: Copy of Revised PALM Screen

Day : Thursday
Date : 9/17/2009

PALM INTRANET

Time: 17:23:10

PTA Calculations for Application: 10/613524

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|--------------------------|------------|-------------------------|-----|
| Application Filing Date: | 07/03/2003 | PTO Delay (PTO): | 941 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 189 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 678 |
| PTO Delay Adjustment: | -74 | | |

File Contents History

| Number | Date | Contents Description | PTO | APPL | START |
|--------|------------|--|-----|------|-------|
| 94 | 09/17/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 74 | |
| 81 | 01/27/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 80 | 01/22/2009 | ISSUE REVISION COMPLETED | | | |
| 79 | 01/22/2009 | DOCUMENT VERIFICATION | | | |
| 78 | 01/21/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 77 | 01/21/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 76 | 01/21/2009 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 75 | 01/21/2009 | NOTICE OF ALLOWABILITY | | | |
| 74 | 01/12/2009 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 73 | 12/22/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 72 | 12/10/2008 | REFERENCE CAPTURE ON IDS | | | |
| 71 | 12/10/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 70 | 12/22/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 69 | 12/10/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 68 | 12/22/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 67 | 12/10/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 66 | 11/17/2008 | DATE FORWARDED TO EXAMINER | | | |
| 65 | 10/30/2008 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 64 | 11/17/2008 | DATE FORWARDED TO EXAMINER | | | |
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|------|------------|---|-----|----|----|
| 63 | 10/30/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 92 | 59 |
| 62 | 11/17/2008 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 61 | 10/30/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 60 | 10/30/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 59 | 04/30/2008 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 58 | 04/28/2008 | FINAL REJECTION | | | |
| 57 | 02/12/2008 | DATE FORWARDED TO EXAMINER | | | |
| 56 | 01/02/2008 | RESPONSE AFTER NON-FINAL ACTION | | 97 | 54 |
| 55 | 01/02/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 54 | 06/27/2007 | MAIL NON-FINAL REJECTION | | | |
| 53 | 06/11/2007 | NON-FINAL REJECTION | | | |
| 52 | 04/29/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 51 | 10/27/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 50 | 03/21/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 49 | 12/08/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 48 | 05/18/2007 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 05/07/2007 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 46 | 04/02/2007 | MAIL RESTRICTION REQUIREMENT | 941 | | -1 |
| 45 | 03/29/2007 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 44 | 12/08/2006 | REFERENCE CAPTURE ON IDS | | | |
| 43.7 | 12/08/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 43 | 12/08/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 42 | 11/01/2006 | MISCELLANEOUS INCOMING LETTER | | | |
| 41 | 07/27/2006 | PRELIMINARY AMENDMENT | | | |
| 40 | 08/01/2006 | ERROR(S) IN CRF CORRECTED BY STIC | | | |
| 39 | 06/22/2006 | MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED) | | | |
| 38 | 06/20/2006 | CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED | | | |
| 37 | 06/15/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
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|------|------------|--|--|--|--|
| 36 | 04/05/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 35 | 12/01/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 34.7 | 03/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 34 | 03/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 33 | 10/27/2004 | REFERENCE CAPTURE ON IDS | | | |
| 32.7 | 10/27/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 32 | 10/27/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 31 | 08/31/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 30 | 04/29/2004 | REFERENCE CAPTURE ON IDS | | | |
| 29.7 | 04/29/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 29 | 04/29/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 28 | 06/25/2004 | RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS | | | |
| 27 | 04/29/2004 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 26 | 05/03/2004 | RECEIPT OF ACKNOWLEDGMENT LETTER | | | |
| 25 | 01/27/2004 | APPLICATION RETURN FROM OIPE | | | |
| 24 | 01/27/2004 | APPLICATION RETURN TO OIPE | | | |
| 23 | 01/27/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 22 | 01/28/2004 | APPLICATION IS NOW COMPLETE | | | |
| 21 | 01/12/2004 | PAYMENT OF ADDITIONAL FILING FEE/PREEXAM | | | |
| 19 | 07/03/2003 | CLAIM PRELIMINARY AMENDMENT | | | |
| 17 | 01/12/2004 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 16 | 11/12/2003 | RECEIPT OF ACKNOWLEDGMENT LETTER | | | |
| 15 | 11/12/2003 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 12 | 10/27/2003 | AGENCY REFERRAL LETTER MAILED | | | |
| 11 | 10/09/2003 | AGENCY REFERRAL LETTER MAILED | | | |
| 10 | 10/09/2003 | AGENCY REFERRAL LETTER MAILED | | | |
| 9 | 10/08/2003 | REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED | | | |

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|---|------------|---|--|--|--|
| 8 | 10/08/2003 | REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED | | | |
| 7 | 10/08/2003 | REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED | | | |
| 6 | 10/07/2003 | CASE CLASSIFIED BY OIPE | | | |
| 5 | 10/07/2003 | REFERRED TO LEVEL 2 (LARS) BY OIPE CSR | | | |
| 4 | 08/12/2003 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 3 | 08/06/2003 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 2 | 07/03/2003 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 1 | 07/03/2003 | INITIAL EXAM TEAM NN | | | |

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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